

REMARKS

Claims 1 and 3-20 are pending in the present application and remain pending upon entry of the instant response. Claims 1-11 and 19-20 are directed to the elected embodiment, while claims 12-18 have been withdrawn but remain pending for rejoinder upon allowance of elected claim 1. Claims 1 and 18 are independent.

Independent claim 1, as well as dependent claims 3-4, 6-7, and 9-11, were rejected under 35 U.S.C. §102(a) over Japanese Publication No. 9021960 to Yasushi et al. (Yasushi). Dependent claims 5-6 were rejected under 35 U.S.C. §103(a) over Yasushi in further view of U.S. Patent No. 4,931,655 to Yoshida et al. (Yoshida). Dependent claim 8 was rejected under 35 U.S.C. §103(a) over Yasushi in further view of U.S. Patent No. 3,393,032 to Crisler et al. (Crisler).

Applicants respectfully traverse this rejection.

First, Applicants note that the Office Action has relied on the Yasushi publication itself. Since the publication itself was used in the rejection and the publication is not in the English language, Applicants respectfully request that the Office provide a translation of Yasushi to Applicants with the next communication. See Ex parte Gavin, Board Pat. App. Interf., Dec. 17, 2001). See also Ex parte Jones, 62 USPQ 2d 1206 (Board Pat. App. Interf., Nov. 28, 2001).

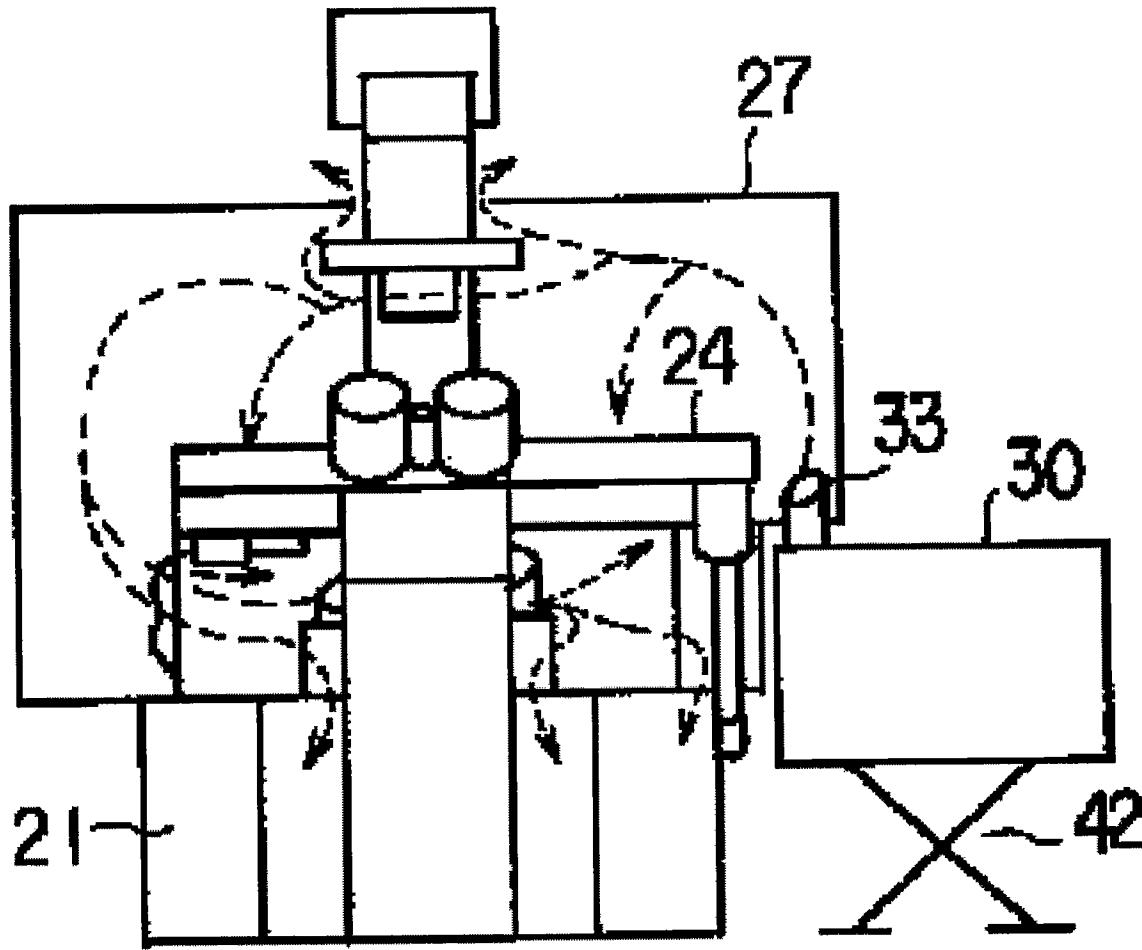
In addition, Applicants respectfully submit that Yasushi fails to disclose or suggest the elements of claim 1.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 recites "a directing device for directing the conditioning medium flow" and that the directing device is "configured to direct the conditioning medium flow to flow at least partially against a sample carrier arranged in the climate compartment (emphasis added)".

The Office Action asserts that Yasushi discloses a housing with a nozzle that directs flow to the upper surface and the lower surface of sample stage (reference numeral 24) as evidenced by the flow lines in Figure 6. For ease of analysis, Figure 6 has been reproduced below.

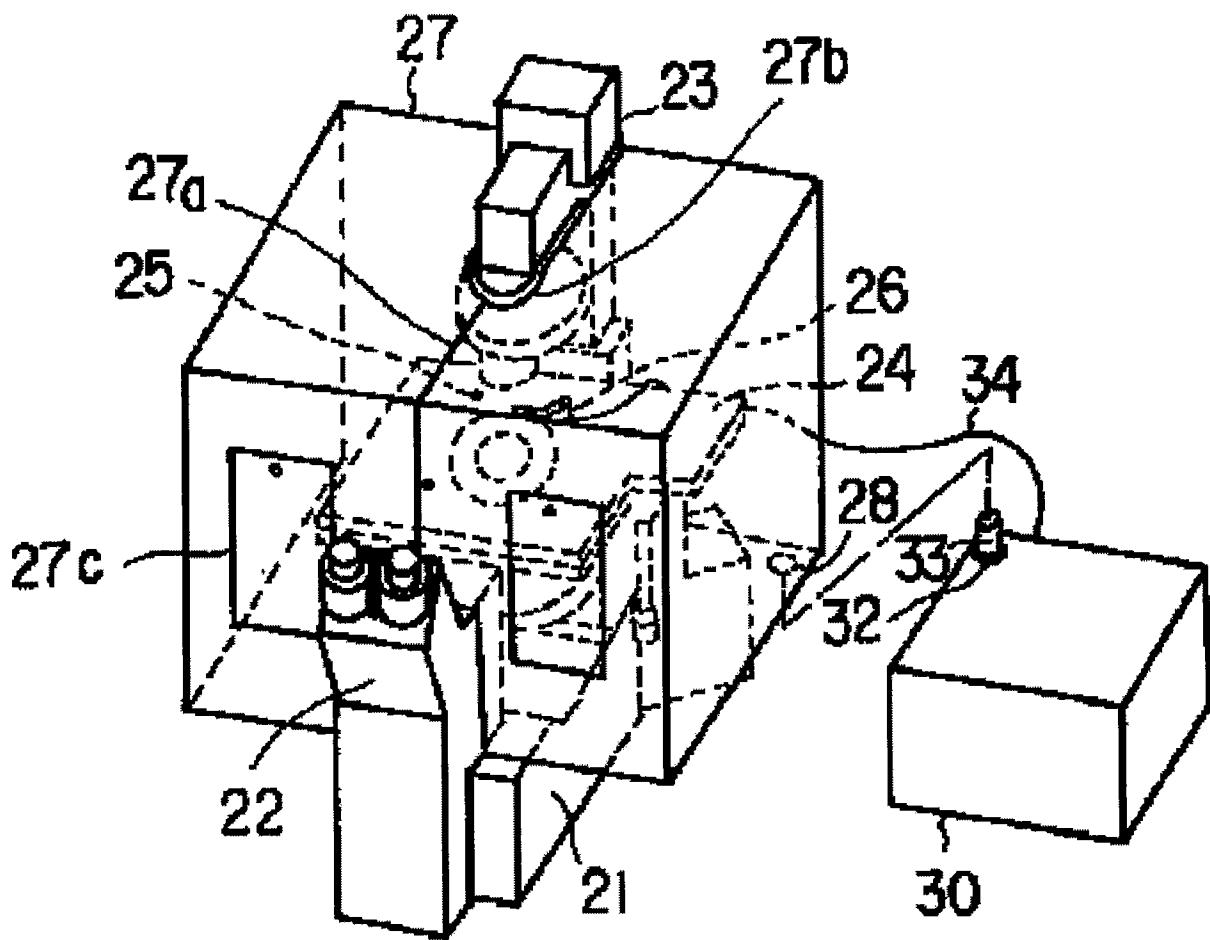
【 FIG 6]



Yasushi, as best understood by the Applicants from an English language Abstract, discloses a heat insulating box 27 that includes a specimen mounting stage 24, where hot air is blown into the box 27. The Abstract further discloses that box 27 has a ventilation port 28 into which a nozzle 33 is inserted, where a hot air fan device 30 draws in and supplies hot air from the external to the box 27 through the nozzle 33 and the port 28. The Abstract establishes that the problem sought to be solved is the elimination of localized temperature point stagnation points and the reduction of the unevenness of temperature distribution within an insulating box.

Applicants further reproduce Figure 1 below for ease of analysis.

【 FIG 1]



Applicants respectfully submit that there is simply no disclosure present in Yasushi that discloses or suggests, in a manner sufficient to establish a *prima facie* case of anticipation, that nozzle 33 directs the hot air flow "at least partially against" specimen mounting stage 24.

To the contrary, nozzle 33 is clearly offset from specimen mounting stage 24 both vertically and horizontally such that the flow of hot air from the nozzle is directed toward the upper surface of insulating box 27 and, not, "at least partially against" the specimen mounting stage 24 as in claim 1.

Thus, Applicants respectfully submit that the assertion made by the Office Action mischaracterizes the teachings of Yasushi, particularly in light of the Office Action's failure to provide an English translation of the document underlying this rejection.

Moreover, Applicants submit that any conclusion that any air passing from nozzle 33 of Yasushi inherently flows at least partly "against" the specimen mounting stage 24, at best, unsupported by the disclosure of Yasushi and more likely specifically contrary to the disclosure of Yasushi, which merely requires the elimination of hot zones.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office Action fails to assert that any of the remaining references, namely Yoshida and/or Crisler, cure the aforementioned deficiencies of Yasushi.

Accordingly, Applicants submit that the cited art does not disclose or suggest claim 1 or claims 3-11 that depend therefrom. Thus, reconsideration and withdrawal of

the rejection to claims 1 and 3-11 are respectfully requested. Further, Applicants request rejoinder and allowance of withdrawn claims 12-18 that depend from claim 1.

Independent claim 19, as well as dependent claim 20, were rejected under 35 U.S.C. §103(a) over Yasushi and Crisler in further view of U.S. Patent No. 3,907,389 to Cox et al. (Cox).

Applicants also respectfully traverse this rejection.

Again, Applicants respectfully request that the Office provide a translation of Yasushi to Applicants with the next communication.

Further, independent claim 19, in part, recites "an inlet opening defined in one of the first plurality of side walls, the inlet opening being configured to supply a conditioning medium flow against the optical device, the illumination device, and a lower side of the sample carrier at a flow approach angle relative to the horizontal between 30° and 60° (emphasis added)".

The Office Action maintains that Yasushi discloses a housing with a nozzle that directs flow to the upper surface and the lower surface of sample stage (reference numeral 24) as evidenced by the flow lines in Figure 6.

Applicants traverse this assertion for the reasons set forth in detail above with respect to claim 1, namely that there is simply no disclosure present in Yasushi that discloses or suggests, in a manner sufficient to establish a *prima facie* case of anticipation or obviousness, that nozzle 33 supplies the hot air flow "against" specimen mounting stage 24.

Further, the Office Action fails to assert that any of the hot air from nozzle 33 is supplied against an optical device or an illumination device. In fact, as best seen from the Figures reproduced above, it appears that the optical device and or illumination

device of Yasushi is external to box 27 and, thus, clearly can not have air from nozzle directed against them.

Moreover, the Office Action acknowledges that Yasushi does not teach an inlet for delivering conditioned media at between 30° to 60°, but rather asserts that the inlet portion of Yoshida "has an approach angle that appears to be in the range of 30° to 60°".

Applicants traverse this assertion.

Importantly, when the reference does not disclose that the drawings are to scale, and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. In re Wright, 569 F.2d 1124, 193 USPQ 332(CCPA 1977). It is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue. See In re Wright, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977) ("Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.").

Further, Section 2125 of the Manual of Patent Examining Procedure states that "proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale."

Yoshida does not disclose that its drawings are to scale and, thus, the figures of Yoshida are simply not useful for determining the approach angle of air flowing therein.

Also, the court in *In re Meng*, 492 F.2d 843 (CCPA 1974) has made a determination of obviousness in a situation analogous to the instant case. The issue in Meng involves a utility patent drawing alleged to render the pending patent application at issue obvious. The facts of this case include prior art references void of any written content to the claimed invention, and the only alleged disclosure of the claimed

limitation at issue was present in a portion of one of the drawings. According to Meng, the question to answer was: "would one of ordinary skill in the art, presented with that problem and those ...prior patents -- and totally unaware of appellants solution-- be led to do what appellants did?" (id at 846).

The Meng court did not find the claim at issue obvious in view of the reference. The court arrived at this conclusion "against the background of the scope and content of the prior art, and the level of ordinary skill in the art" (id at 846). The court noted that when the references were read "without the benefit of appellants' teachings", it had nothing to do with the invention at issue. The court went on to say "we are further stayed from a holding of obviousness when, as here, the drawing occurs in a reference in no way directed toward the problem involved, and the drawing must be viewed in a teaching vacuum so far as the invention before us is concerned" (id at 848). In doing so, the court upheld the well-established rule "references must be evaluated by ascertaining the facts fairly disclosed therein as a whole" In re Schuman 361 F.2d 1008, 1012, 53 CCPA 1251, 1255 (1966) (emphasis added).

Similarly, in the present case, Yoshida is directed to a device for accelerated weather testing and, not preventing condensation on a microscope and, thus, the drawing of Yoshida occurs in a reference in no way directed toward the problem involved.

Accordingly, Applicants submit that the assertion that Yoshida "appears to be in the range of 30° to 60°" fails to disclose or suggest claim 19.

The Office Action fails to assert any of the remaining references cure the aforementioned deficiencies.

In sum, Applicants respectfully submit that the assertions made by the Office Action mischaracterizes the teachings of Yasushi, particularly in light of the Office Action's failure to provide an English translation of the document underlying this

rejection and mischaracterize the disclosure of Yoshida by merely referring to its drawings, which are not to scale.

In addition, claim 20 recites that "the first plurality of side walls are at an angle of more than 90° relative to each other and the second plurality of side walls are at an angle of more than 90° relative to each other (emphasis added)".

The Office Action asserts that the size and orientation of the sidewalls is a matter of preferred design choice.

Applicants respectfully disagree.

This type of "design choice" rejection has been criticized by the Court of Appeals for the Federal Circuit. In the case of *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1995) (citing *In re Gal*, 25 USPQ2d 1076 (Fed. Cir. 1992)), the Federal Circuit reversed a Board of Appeals rejection based on design choice and held that a "finding of 'obvious design choice' precluded where the claimed structure and the function it performs are different from the prior art."

The present application provides that the housing is configured such that it promotes an optimum flow so that only a very small quantity of condensate is found at the housing inner wall. This optimal flow was determined by the present application to be provided by a configuration where the medium flow flows against the interior of the housing, and there are hardly any "dead nooks". See page 3, line 30 through page 4, line 6.

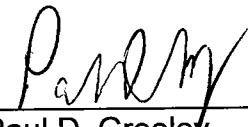
Accordingly, claims 19 and 20 are each patentable over the proposed combination of cited art. Reconsideration and withdrawal of the rejections to claims 19 and 20 are respectfully requested.

In view of the above, it is respectfully submitted that the present application is in condition for issuance. Such action is solicited.

Furthermore, Applicants submit that the Office Action failed to make a *prima facie* case of anticipation/obviousness of the pending claims in view of Yasushi. Thus, it is respectfully submitted that any action finally rejecting the present application over Yasushi would be premature in light of the Office Action's failure to present a *prima facie* case of anticipation/obviousness.

If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

Respectfully submitted,



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